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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,616	01/20/2004	Ruguo Hu	88265-7643	3530
29157 7590 02/03/2009 BELL, BOYD & LLOYD LLP P.O. Box 1135 CHICAGO, IL 60690				
EXAMINER				
LEFT, STEVEN N				
ART UNIT		PAPER NUMBER		
1794				
NOTIFICATION DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATENTS@BELLBOYD.COM

Office Action Summary

Application No.

10/761,616

Applicant(s)

HU ET AL.

Examiner

STEVEN LEFF

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- Claims 1-8, 10-16, and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Stipp (5554400).

Stipp teaches a beverage portioned package and a method for making a beverage portioned package (title) for preparing a beverage in an extraction device (col. 8 lines 30-35) in which the package is held between a water supplying part and a receiver of the device (col. 8 lines 30-35). More specifically Stipp teaches with respect to claim 1 a first surface for receiving water and allowing the water to flow into and through the package (col. 8 lines 14-29, col. 7 lines 63-65) under pressure when the package is operatively associated with the extraction device to form the beverage (col. 8 lines 30-35), a second surface that allows for the beverage to flow there through so that the beverage can be collected in the receiver of the device (col. 8 lines 14-29, col. 7 lines 63-65), where it is noted that Stipp teaches a sheet folded over and attached along three sides. In addition, the package contains a water-soluble beverage material in an amount sufficient to form the beverage (col. 9 lines 24-27, col. 11 line 37) and a filler comprising a water insoluble material (col. 3 lines 30-60) adapted to maintain extraction pressure of the beverage during progressive dissolution of the water-soluble beverage material at a pressure above that which is created by the sole resistance of the first and second surfaces when the package is emptied of the water-soluble material (col. 9 lines 32-37), and that the ratio of water-soluble material to filler is between 1:1 and 1:8 and more specifically 1:1 and 1:6 by volume (col. 9 lines 24-28, col. 9 lines 10-12, col. 11 lines 36-37).

Stipp continues by teaching with respect to claims 2-4 that the filler is present in an amount sufficient to form a pressure resistance bed (col. 9 lines 32-37), that the pressure resistance bed extends through the entire package (col. 15 lines 18-21), and that the pressure resistance bed comprises discrete pieces of the filler in the form of

particulates, granules, flakes, fibers or combinations thereof (col. 9 lines 7-10, col. 3 lines 30-60). Stipp further teaches that the pressure resistance bed comprises at least one continuous porous piece in the form of a compacted piece (col. 8 lines 31-63), that the filler comprises a water-absorbent material which includes fresh ground coffee, spent ground coffee or a combination thereof (col. 3 lines 23-60), that the water-soluble material comprises coffee that is present in an amount that provides at least 10 to 40 weight percent of the total coffee solids in the final beverage (col. 9 lines 24-28, col. 9 lines 10-12) and that the water-soluble material includes soluble coffee powder, milk powder, a creamer substitute powder or mixtures thereof (col. 9 lines 25-26, col. 4 lines 1-60). Although Stipp does not specifically state a percentage of absorbency rate for the package, Stipp does teach the same referenced materials at applicants desired ratio by volume and thus Stipp is taken to meet the instant claims since it would be expected that the percentage of absorbency rate for the package would thus be the same, absent any clear and convincing evidence and/or arguments to the contrary.

Stipp further teaches that the filler contains a soluble or water extractable substance for aromatizing or flavoring the beverage (col. 5 lines 21-42), where the soluble or extractable substance is an aroma, coffee, an artificial flavor or a natural flavor (col. 5 lines 21-42), that the first and second surfaces are walls made of a water-permeable material (col. 8 lines 25-31), and specifically filter paper sheets (col. 8 line 54) or plastic (col. 7 line 67) which has semi-solid walls which are pre-opened (col. 7 line 65). In addition, Stipp teaches the addition of a foaming creamer (col. 14 lines 59-60) yielding a beverage having a high foamed head (col. 15 line 3).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
- Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stipp (5554400).

With respect to claim 17 Stipp is silent with respect to the first and second surfaces being disk-shaped sheets.

However Stipp teaches first and second surfaces manufactured from filter paper and interconnected adjacent their peripheral edges, with the interconnected parts of the sheets forming an annular sealing seam to allow the package to be held in the extraction device (col. 8 lines 25-35) and thus one skilled in the art could have used specifically a disc shaped filter paper with no change in their respective functions, thus yielding predictable results to one of ordinary skill in the art at the time of the invention. Therefore, since MPEP 2144.07 states that the selection of a known process based on its suitability for its intended use supports a prima facie obviousness determination and thus it would have been obvious to one of ordinary skill in the art to teach a specific shape, specifically disc shaped since Stipp specifically teaches adapting the “shape and design” of the bag with respect to the specific brewing method (col. 8 lines 33-35).
 - Claims 1-8, 10-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kane (2110732) in view of Cai (6777007).

Kane teaches a beverage portioned package and a method for making a beverage portioned package (pg. 1 col. 2 lines 26-35) for preparing a beverage in an extraction device in which the package is held between a water supplying part and a receiver of the device (pg. 2 col. 2 lines 11-17) where it is noted that the water supplying part is interpreted as the water being poured and the cup is interpreted as the receiver where the package is on the receiver.

More specifically Kane teaches with respect to claim 1 a bag or sack for receiving water and allowing the water to flow into and through the package (pg. 1 col. 2 line 37) under pressure when the package is operatively associated with the extraction device to form the beverage (pg. 1 col. 2 line 37), that allows for the beverage to flow there through so that the beverage can be collected in the receiver of the device (pg. 1 col. 2 lines 63-65), where the package contains a water-soluble beverage material in an

amount sufficient to form the beverage (pg. 2 col. 2 lines 11-17), a filler comprising a water insoluble material (pg. 1 col. 1 lines 25-35) adapted to maintain extraction pressure of the beverage during progressive dissolution of the water-soluble beverage material at a pressure above that which is created by the sole resistance of the first and second surfaces when the package is emptied of the water-soluble material (pg. 2 col. 1 lines 35-45, pg. 2 col. 2 lines 30-35), and that the ratio of water-soluble material to filler is between 1:1 and 1:8 and more specifically 1:1 and 1:6 by volume (pg. 2 col. 2 lines 34-38).

Kane continues by teaching with respect to claims 2-4 that the filler is present in an amount sufficient to form a pressure resistance bed (pg. 2 col. 2 lines 35-45), that the pressure resistance bed extends through the entire package (pg. 1 col. 2 lines 18-20), and that the pressure resistance bed comprises discrete pieces of the filler in the form of particulates, granules, flakes, fibers or combinations thereof (pg. 2 col. 1 lines 17-33). Kane further teaches that the filler comprises a water-absorbent material which includes fresh ground coffee, spent ground coffee or a combination thereof (pg. 2 col. 1 lines 18-32), that the water-soluble material comprises coffee that is present in an amount that provides at least 10 to 40 weight percent of the total coffee solids in the final beverage (pg. 3 col. 2 lines 34-38) and that the water-soluble material includes soluble coffee powder (pg. 3 col. 1 lines 54-56). It is noted that although Kane does not specifically state a percentage of absorbency rate for the package, Kane does teach the same referenced materials at applicants desired ratio by volume and thus Kane is taken to meet the instant claims since it would be expected that the percentage of absorbency rate for the package would thus be the same, absent any clear and convincing evidence and/or arguments to the contrary.

Kane further teaches that the filler contains a soluble or water extractable substance for aromatizing or flavoring the beverage (pg. 1 col. 2 lines 31-35), where the soluble or extractable substance is an aroma, coffee, an artificial flavor or a natural flavor (pg. 1 col. 2 lines 31-35), that the first and second surfaces are walls made of a water-permeable material (pg. 1 col. 2 lines 37-39), which has semi-solid walls which are pre-opened (pg. 1 col. 2 lines 31-35).

However Kane is silent with regard to specifically stating that the bag or sack comprises a first surface for receiving water and allowing the water to flow into and through the package and a second surface that allows for the beverage to flow there

through so that the beverage can be collected in the receiver of the device, in addition to being silent with respect to the pressure resistant bed comprising at least one continuous porous piece in the form of a web, a mat, a compacted piece, a foam or a combination thereof, that the first and second surfaces being disk-shaped sheets, a sealing seam for interconnecting the filter paper, and processing the package in an extraction device thus facilitating the formation of a foam on the beverage where the material is filter paper or plastic.

Cai teaches a method for making coffee, espresso, hot chocolate, mocha, latte or the like using a pod. "The pod contains first and second flavor-containing materials which are intended to be different materials to make blended drinks such as latte, cappuccino, mocha, milk-containing coffee and flavored espresso or coffee drinks. For example, when the first flavor-containing materials is the amount of milk particles required for making latte and the second flavor-containing materials is espresso coffee grounds, latte will be made from the pod (col. 9 lines 61-64, col. 10 lines 1-5). It is noted that latte includes foam.

Cai further teaches a method for using the pod to make coffee, espresso, hot chocolate, mocha, latte or the like. The method comprises placing the pod(s) into a pod holder, forming a seal between the side wall and/or sealing seam of the pod(s) and the substantially vertical side wall of the pod holder when the pod is placed into the pod holder and the sealing seam is positioned inside the substantially vertical side wall of the pod holder (col. 6 lines 47-65), mounting the pod holder to a beverage apparatus, (col. 10 line 52-54) introducing hot water to the pod and forcing the water through the flavor-containing materials to extract or dissolve the flavor-containing materials to form fluid comestible, and discharging the fluid comestible into a receptacle such as a cup (col. 11 lines 1-10) through the filter paper (col. 5 line 26) or plastic body thereof (col. 5 line 47).

Therefore, although Kane does not teach the placement of the beverage package within an extraction device where the resultant beverage contains foam due to the pressure of the water being introduced into the package, Kane does teach all of the limitations with regard to the beverage portioned package, in addition to teaching pouring water over the package while in a receiver (pg. 2 col. 2 lines 15-16) where Cai teaches the desire to provide a seam which can be long enough to function as a handle (col. 6 lines 20-22) and thus one of ordinary skill in the art would have been motivated to

combine the teaching of Kane and Cai since providing an automatic or mechanical means to replace a manual activity, which accomplishes the same result, is not sufficient to distinguish over the prior art (see MPEP 2144.04III).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to have made or produced a beverage package containing both soluble and insoluble materials that is placed in an extraction device to produce a foamy beverage in order to more accurately control the amount of liquid, the strength and to provide a more timely manner of obtaining a coffee drink as is desired by Cai (col. 2 lines 55-63).

Further although Kane is silent with respect to the specific shape of the package or that the package is specifically filter paper or plastic, Kane does teach a bag manufactured from water permeable paper and thus one skilled in the art could have used specifically a disc shaped filter paper with no change in their respective functions, thus yielding predictable results to one of ordinary skill in the art at the time of the invention. Therefore, since MPEP 2144.07 states that the selection of a known process based on its suitability for its intended use supports a prima facie obviousness determination it would have been obvious to one of ordinary skill in the art to teach a specific shape or a specific type of material which allows the product to diffuse there through as is desired by Kane, which is specifically disc shaped since Cai specifically teaches the sealing seam being long enough to function as a handle for the pod (col. 6 lines 20-22) in addition to teaching that the pod can adopt various shapes and materials (col. 5 lines 45-48) in addition to specifically teaching a disc shape (col. 6 line 38, fig. 4).

With respect to Kane being silent that the pressure resistant bed comprising at least one continuous porous piece in the form of a web, a mat, a compacted piece, a foam or a combination thereof, Kane does desire to provide a pressure resistant bed (pg. 2 col. 2 lines 35-45) and thus it would have been obvious to one of ordinary skill in the art to combine the teachings of Kane and Cai and produce a beverage package containing soluble and insoluble materials that is used in an extraction device to make a foamy coffee beverage further comprising at least one continuous porous piece in the form of a web, a mat, a compacted piece, a foam or a combination thereof in order to provide a package for use with an extraction machine for its art recognized and applicant's intended purpose of the providing a beverage pod that is sufficiently dried and drip-free right after

preparing the beverage (col. 2 lines 65-68) thereby increasing its appeal to the consumer due to the cleanliness thereof making the product more desirable due to this advantage (col. 2 lines 57-68).

Response to Arguments

In response to applicant's arguments against the references individually it is noted that, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the instant case Cai specifically teaches a first surface for receiving water and allowing the water to flow into and through the package and a second surface that allows for the beverage to flow there through so that the beverage can be collected in the receiver of the device, in addition to being silent with respect to the pressure resistant bed comprising at least one continuous porous piece in the form of a web, a mat, a compacted piece, a foam or a combination thereof, that the first and second surfaces being disk-shaped sheets, a sealing seam for interconnecting the filter paper, and processing the package in an extraction device thus facilitating the formation of a foam on the beverage where the material is filter paper or plastic as was discussed above.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Leff whose telephone number is (571) 272-6527. The examiner can normally be reached on Mon-Fri 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer McNeil can be reached on (571) 272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Drew E Becker/
Primary Examiner, Art Unit 1794

/Steven Leff/
Examiner, Art Unit 1794